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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,046	10/22/2003	Richard S. Valpey III	J-3456A	2051
7590	06/05/2006		EXAMINER	
Frank B. McDonald S.C. Johnson & Son, Inc. 1525 Howe Street Legal Department - MS 077 Racine, WI 53403			MRUK, BRIAN P	
			ART UNIT	PAPER NUMBER
			1751	
			DATE MAILED: 06/05/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/691,046	VALPEY ET AL.	
	<b>Examiner</b> Brian P. Mruk	<b>Art Unit</b> 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 March 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-36 is/are pending in the application.
  - 4a) Of the above claim(s) 3-9, 26 and 29-36 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 2, 10-25, 27 and 28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 October 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/5/04 &amp; 10/22/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I, claims 1-28, in the reply filed on March 29, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 3-9 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 29, 2006.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 10-12, 15-25 and 28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cavanagh et al, U.S. Patent No. 5,256,328.

Cavanagh et al, U.S. Patent No. 5,256,328, discloses a liquid toilet bowl cleaner comprising a halogen donating compound in nanoparticles form, wherein the nanoparticles preferably have a size of less than 100 nm (see abstract, col. 1, lines 36-51, and col. 2, lines 43-68), and a fluorosurfactant, such as Zonyl FSD (see abstract and col. 3, lines 39-55). It is further taught by Cavanagh et al that the composition also contains 20-40% by weight of water (see abstract) and conventional additives, such as surfactants, neutralizers, disinfectants, and thickeners (see col. 3, lines 29-39), per the requirements of the instant invention. Specifically, note Example 2. The examiner asserts that the detergent products disclosed in Example 2 of Cavanagh et al would inherently meet the pH and surface energy requirements of the instant invention, since the detergent products disclosed in Example 2 of Cavanagh et al contain all of the required components in the amounts required in the instant claims, absent a showing otherwise. Furthermore, the examiner asserts that "The fact remains that one of ordinary skill informed by the teachings of Cavanagh et al would not have had to choose judiciously from a genus of possible combinations to obtain the very subject matter to which appellant's composition per se claims are directed." *In re Sivaramakrishnan*, 213

USPQ 441 (CCPA 1982). Therefore, instant claims 1-2, 10-12, 15-25 and 28 are anticipated by Cavanagh et al, U.S. Patent No. 5,256,328.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

6. Claims 1-2, 10-25 and 27-28 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rohrbaugh et al, WO 01/96511.

Rohrbaugh et al, WO 01/96511, discloses a coating composition comprising a nanoparticles system that imparts a surface modifying benefit to hard surfaces (see abstract). It is further taught by Rohrbaugh et al that the composition further contains a hydrophobic surface modifier, such as fluorosurfactants (see page 6, lines 13-19 and page 27, line 2-page 28, line 10), that the nanoparticles have a particle size of 1-400 nm (see page 11, lines 1-13), and that suitable nanoparticles include fluorosurfactants, colloidal silica, and inorganic metal oxides, such as zinc oxide and titanium dioxide (see page 11, line 33-page 15, line 28), per the requirements of the instant invention.

Rohrbaugh et al further discloses that the composition further contains water (see page 23, lines 13-32), surfactants (see page 32, lines 22-24), and dispersants (see page 44, lines 1-13), and also teaches that the pH of the composition may be as low as 3, and as high as 11 (see page 38, lines 27-29). Specifically, note Examples 1-33. The examiner

asserts that the coating compositions disclosed in Rohrbaugh et al would inherently meet the surface energy requirements of the instant invention, since the coating compositions disclosed in Rohrbaugh et al contain all of the required components in the amounts required in the instant claims, absent a showing otherwise. Furthermore, the examiner asserts that "The fact remains that one of ordinary skill informed by the teachings of Rohrbaugh et al would not have had to choose judiciously from a genus of possible combinations to obtain the very subject matter to which appellant's composition per se claims are directed." *In re Sivaramakrishnan*, 213 USPQ 441 (CCPA 1982). Therefore, instant claims 1-2, 10-25 and 27-28 are anticipated by Rohrbaugh et al, WO 01/96511.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00AM-5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1751

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPM

Brian P Mruk  
May 30, 2006

Brian P. Mruk

Brian P Mruk  
Primary Examiner  
Art Unit 1751